Docket No.: 0365-0638PUS1
(Patent)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application of: Jukka SALONEN		**Before the Board of Appeals**	
Application No.:	10/734,352	Confirmation No.:	3575
Filed:	December 11, 2003	Art Unit:	3628
For:	BOOKING METHOD AND SYSTEM	Examiner:	S. SALIARD

APPEAL BRIEF

MS APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is in furtherance of the Notice of Appeal filed in this case on November 25, 2009.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

Docket No.: 0365-0638PUS1
(Patent)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application of: Jukka SALONEN		**Before the Board of Appeals**	
Application No.:	10/734,352	Confirmation No.:	3575
Filed:	December 11, 2003	Art Unit:	3628
For:	BOOKING METHOD AND SYSTEM	Examiner:	S. SALIARD

APPEAL BRIEF ON BEHALF OF APPELLANT

MS APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I. REAL PARTY IN INTEREST

The real party in interest for this application is the Assignee, BOOKIT OY AJANVARAUSPALVELU.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 4 claims pending in application.

B. Current Status of Claims

1. Claims canceled: 1-18, 20, and 24-27
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 19 and 21-23
4. Claims allowed: None
5. Claims rejected: 19 and 21-23

C. Claims on Appeal

The claims on appeal are claims 19 and 21-23.

IV. STATUS OF AMENDMENTS

No amendments have been presented after the Final Rejection of May 28, 2009.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 19 defines a method of a mediator authenticating a client, the client using a mobile telephonic device capable of sending and receiving short message service (SMS) messages and having a client identifier address. The method includes, *inter alia*, assigning a unique reply address to an SMS message from a multiplicity of available predefined reply addresses (see e.g., page 19, line 7 to page 20, line23 of the Specification and Figs. 6 and 8); sending the SMS message to the client at the client identifier address (see e.g., page 20, lines 8-23 of the Specification and Fig.6); and when a SMS message is received at the unique reply address authenticating the client(see e.g., page 20, line 26 to page 21, line 25 of the Specification and Fig.6).

Independent claim 22 defines a network server for performing a method of authenticating a client, the client using a mobile telephonic device capable of sending and receiving short message service (SMS) messages and having a client identifier address, the network server configured to perform the steps of: assigning a unique reply address to an SMS message from a multiplicity of available reply addresses (see e.g., page 19, line 7 to page 20, line23 of the Specification and Figs. 6 and 8); sending the SMS messages to the client at the client identifier address (see e.g., page 20, lines 8-23 of the Specification and Fig.6); and when a SMS message

is received at the unique reply address, authenticating the client (see e.g., page 20, line 26 to page 21, line 25 of the Specification and Fig.6).

The summary to the claimed invention herein is being made to comply with the Patent Office rules in submitting Briefs and is not to be considered as limiting the claimed invention.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The Final Office Action provides one (1) ground of rejection for review on appeal.

1) Claims 19, and 21-23 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

2) Claims 19, and 21-23 stand under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,085,100 to Tarnanen ("Tarnanen") in view U.S. Patent Publication No. 2002/0028686 to Kagi ("Kagi"), further in view of U.S. Patent No. 7,149,537 to Kupsh et al. ("Kupsh").

VII. ARGUMENTS

A. The rejection of claims 19 and 21-23 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is improper.

The examiner has the initial burden of establishing, by a preponderance of evidence, that a person skilled in the art would not recognize in Applicant's disclosure a description of the invention defined by the claims. *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976). In rejecting claims 19 and 21-23, the Examiner asserts that "there is no support within the specification for the limitation 'assigning a unique reply address to the SMS message from a multiplicity of available predefined reply address'" because although the specification discloses "assigning the addresses at random...there is no mention of the addresses being predefined."

As discussed on page 20, lines 8-23 of the Specification as filed, the present invention utilizes a dynamic dialog matrix including a column/row for each client and a corresponding row/column for each A subscriber number the mediator is using. As a result, the mediator needs only a limited number of A subscriber numbers (i.e., predefined reply addresses) and the dialog matrix can be used to determine which A subscriber numbers are available for the next inquiry (see e.g., page 20, lines 20-23 of the Specification). Therefore, although the specification does

not specifically recite the term "predefined", one skilled in the art would readily understand the claimed "multiplicity of available predefined reply addresses" is supported by the set of reply addresses (A subscriber numbers) utilized by the mediator in the specific examples disclosed in the Specification as filed.

Although the Specification also discusses the fact that the particular reply address assigned to a question is preferably a randomly chosen reply address, one skilled in the art would readily appreciate that for the system as a whole to work using randomly chosen reply addresses as discussed, the chosen reply address must inherently come from a predefined group of reply addresses available to the mediator. Otherwise, the mediator would have no way of receiving the reply message, i.e., if a random reply address not previously assigned/available to the mediator, the mediator would never receive the reply. Accordingly, the Specification as originally filed clearly provides sufficient description for the claimed invention. The Examiner's rejection of claims 19 and 21-23 under 35 U.S.C. 112, first paragraph, should be reversed.

B. The rejection of claims 19, and 21-23 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Tarnanen, Kagi, and Kupsh is improper because the combination fails to each and every claimed element.

In order to support a rejection under 35 U.S.C. § 103, the Examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness three criteria must be met. First, there must be some rationale to combine the cited references. Second, there must be a reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, claims 19 and 21-23 are patentable over the combination of Tarnanen, Kagi, and Kupch for at least the reason that the combination fails to disclose each and every claimed element as discussed below.

Independent Claim 19

Independent claim 19 defines a method of a mediator authenticating a client, the client using a mobile telephonic device capable of sending and receiving short message service (SMS) messages and having a client identifier address. The method includes, *inter alia*, assigning a unique reply address to an SMS message from a multiplicity of available predefined reply addresses; sending the SMS message to the client at the client identifier address; and when a

SMS message is received at the unique reply address authenticating the client. As mentioned above, in order to establish a *prima facie* case of obviousness, the cited combination must teach each and every claimed element. Claim 19 is patentable over the combination of Tarnanen, Kagi, and Kupsh for at least the reason that the combination fails to disclose or suggest "assigning a unique reply address to an SMS message from a multiplicity of available predefined reply addresses" as recited in claim 19.

In rejecting claim 19, the Examiner asserts that "Tarnanen discloses a) assigning a unique reply address to an SMS message from a multiplicity of available reply addresses", but "does not disclose that the reply addresses are predefined." (Final Action p. 4). The Examiner further asserts that Kupsh "discloses that the reply addresses are predefined." (Id.) Therefore, the Examiner concludes that it would have been obvious for one skilled in the art to substitute "the predefined address of Kupsh et al for the reply address of Tarnanen" because it would have been a simple substitution of one known element for another producing a predictable result. (Final Action p. 5). However, Appellant asserts that the Examiner's conclusion is flawed because the Examiner's assertions regarding the teachings of the prior art (on which the conclusion is based) are unfounded.

First, Appellant disagrees with the Examiner's assertion that Tarnanen discloses "assigning a unique reply address to a SMS message from a multiplicity of available reply addresses." Tarnanen discloses a method for routing short messages via a short message gateway application in a digital mobile system. According to Tarnanen a short message reply is routed to its original source address by means of a dynamic database connected to the system and therefore it is not necessary to permanently store the information related to the routing in short message service centers or in associated gateway applications (Tarnanen, col. 2, ll. 27-31). More specifically, Tarnanen discloses that a gateway application connect to an SMSC receives a data message from the address "omaddr" which is to be forwarded to a mobile station at the address "daddr", then the gateway application generates a message having a source address formed by supplementing the gateway's address "gaddr" with the parameter "scts", wherein the parameter "scts" is a time stamp. (Tarnanen, col. 7, ll. 15-55) In other words, Tarnanen does not assign a replay address from a multiplicity of available reply addresses, but rather Tarnanen uniquely identifies the reply messages by modifying a single reply address "gaddr" with a time stamp "scts" as transmission, i.e., the temporary source address of Tarnanen is simply generated by

combining a current time code stamp with the gateway's address. As a result, there is only one possible (i.e., available) address to be assigned in Tarnanen. Therefore, Tarnanen cannot possibly be interpreted as selecting from a multiplicity of available predefined addresses as asserted by the Examiner.

Kupsh discloses a system and method for providing a user-accessible Internet-based mobile messaging log that records messages communicated between an Internet-based sending device and an SMS-capable mobile device. As discussed in column 6, lines 17-36 of Kupsh, the message log 302 provides a listing of all messages sent by a user having the same user name and similar message logs can be created for messages sent by other users. However, nowhere in Kupsh is there any disclosure or suggestion of assigning/selecting a reply address from a group of available predefined replay messages as claimed. Furthermore, the Examiner incorrectly asserts that Kupsh teaches that the originating address is used to generate the reply address. Although Kupsh teaches a system wherein a user can send an SMS message from a webpage of an Internet Gateway to a SMS-capable mobile device, Kupsh does not disclose using the originating address to generate a reply address. To the contrary, Kupsh teaches generating the reply address based on the unique tracking identification number associated with the user, e.g., REPLYIDXXXXXX@v.w, where XXXXXX is the unique tracking number. (Kupsh, col. 5, ll. 18-30)

Kagi discloses a method, system, and device for a short message service ordering system for mobile terminals. More specifically, Kagi pertains to a method and apparatus for making offers for sale, and accepting offers for sale of goods using the short message service of a mobile telephone. (Kagi, ¶ [0003]). However, Kagi fails to overcome the deficiencies of Tarnanen and Kupsh.

Since Tarnanen, Kagi, and Kupsh each fail to disclose or suggest assigning a unique reply address to an SMS message from a multiplicity of available predefined reply addresses as claimed, the combination of these three references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art has some rationale to combine Tarnanen, Kagi, and Kupsh (which Applicant does not concede) the combination would still fail to render claims 19 and 21-23 unpatentable because the combination fails to disclose each and every claimed element. For at least this reason, Appellant respectfully requests reversal of the Examiner's rejection of claim 19 under 35 U.S.C. § 103(a).

Claims 21-23 are patentable over the combination of Tarnanen, Kagi, and Kupsh for at least those reasons presented above with respect to claim 19. Accordingly, Appellant respectfully requests reversal of the Examiner's rejection of claims 21-23 under 35 U.S.C. § 103(a).

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A.

IX. EVIDENCE

There is no additional evidence pursuant to §§ 1.130, 1.131, or 1.132 and/or evidence entered by or relied upon by the examiner that is relevant to this appeal as noted in Appendix B.

X. RELATED PROCEEDINGS

No related proceedings are referenced in II. above, and thus, copies of decisions in related proceedings are not provided.

XI. CONCLUSION

The withdrawal of the outstanding rejections and the allowance of claims 19 and 21-23 are earnestly solicited.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

Dated: January 25, 2010

Respectfully submitted,

By Penny Caudle #46,607

Michael K. Muller
Registration No.: 29680
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road, Suite 100 East
P.O. Box 747
Falls Church, VA 22040-0747
703-205-8000

APPENDIX A

Claims Involved in the Appeal of Application No. 10/734,352

19. A method of a mediator authenticating a client, the client using a mobile telephonic device capable of sending and receiving short message service (SMS) messages and having a client identifier address, the mediator performing acts including:

a) assigning a unique reply address to an SMS message from a multiplicity of available predefined reply addresses;

b) sending the SMS message to the client at the client identifier address; and

c) when a SMS message is received at the unique reply address authenticating the client.

21. The method of claim 19, wherein the method further includes storing the reply in a matrix including a first axis indexed by client calling line identifier number and a second axis indexed by reply address.

22. A network server for performing a method of authenticating a client, the client using a mobile telephonic device capable of sending and receiving short message service (SMS) messages and having a client identifier address, the network server configured to perform the steps of:

assigning a unique reply address to an SMS message from a multiplicity of available reply addresses;

sending the SMS message to the client at the client identifier address; and

when a SMS message is received at the unique reply address authenticating the client.

23. The method of claim 19, wherein the client's identifier address includes an identifier chosen from the group consisting of a client's a-subscriber's number, Calling Line Identity, e-mail address and IP address.

APPENDIX B

There is no additional evidence pursuant to §§ 1.130, 1.131, or 1.132 and/or evidence entered by or relied upon by the examiner that is relevant to this appeal.

APPENDIX C

There are no related proceedings.